REMARKS

1. Reconsideration and further prosecution of the above-identified application are respectfully requested in view of the amendments and discussion that follows. Claims 1-22 are pending in this application.

Claims 1-16 have been rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. Claims 1-22 have been rejected under 35 U.S.C. §103(a) as being obvious over U.S. Pat. No. 6,516,302 to Deaton. After a careful review of the claims (as amended), it has been concluded that the rejections are in error and the rejections are therefore traversed.

2. Claims 1-16 have been rejected as being directed to non-statutory subject matter. In response, claim 1 has been further limited to accumulating data about customers from a plurality of independent vendors within a database of a third party. Claim 17 has been similarly limited to "a database of a third party that contains customer information provided by a plurality of independent vendors regarding their respective customers". Support for this limitation may also be found in numerous locations throughout the specification (e.g., page 3, lines 22-32; page 7, lines 20-22; FIG. 1, etc.).

Claim 1 is now clearly defined in terms that would be well understood to those of skill in the art. Since claim 1 is now clearly defined, the rejection under 35 U.S.C. §101 is now believed to be improper and should be withdrawn.

It is noted next that claim 9 has also been rejected as being drawn to non-statutory subject matter. In this

regard, the Examiner asserts that "it is considered improper to read limitations contained in the specification into the claims" (Office Action of 3/12/04, page 3).

However, claim 9 is a means-plus-function claim under 35 U.S.C. §112, paragraph 6. In this regard "The plain and unambiguous meaning of paragraph 6 is that one construing means-plus-function language in a claim must look to the specification and interpret that language in light of the corresponding structure, material, or acts described therein . . . Paragraph six does not state or even suggest that the PTO is exempt from this mandate". *In re Donaldson Co. Inc.* 29 USPQ2d, 1848 (App.Ct. Fed. Ct. 1994). Further, the Examiner is "required by statute to look to . . . specification and construe the 'means' language recited in . . . claim 1 as limited to the corresponding structure disclosed in the specification and equivalents thereof". *In re Donaldson Co. Inc.* 29 USPQ2d, 1850 (App.Ct. Fed. Ct. 1994). Since the Examiner has clearly not done this, the rejection of claims 8-16 are believed to be improper and should be withdrawn.

3. Claims 1-22 have been rejected as being obvious over Deaton. In response claims 1 and 17 have been further limited to identifying customers in the context of a plurality of independent vendors who independently provide data about their respective customers. Support for this additional limitation has been discussed above.

It is noted first, the Examiner admits that "Deaton lacks an explicit recitation of the elements and limitations of claim 1, even though Deaton . . . suggests same" (Office Action of 3/12/04, pages 5-6). The Examiner also asserts that independent claims 9 and 17 have been

rejected "for substantially the same reasons as independent claim 1" (Office Action of 3/12/04, page 8). Since the Examiner has rejected independent claims 9 and 17 on the same basis as claim 1 and since the Examiner admits that Deaton does not contain the elements of claim 1, the Examiner is also apparently admitting that Deaton also fail to teach or suggest the elements of independent claims 9 and 17.

In this regard, it is noted that Deaton describes a fundamentally different system than that of the claimed invention. For example, the claimed invention is, in all cases, limited to the use of a database of a third party by independent vendors who independently provide data about their respective customers for purposes of forwarding promotional materials to potential customers. In contrast, under Deaton, "The check transaction processing system of the present invention enables a store with a significant volume of check transactions to accumulate and process transactional customer information for check verification and . . . operates at the store using a local database" (Deaton, col. 5, lines 53-58). Further, even in the case of "a multiple store b business, a local system is located at each store and global customer information transfers are used to supplement the essentially local customer database" (Deaton, col. 6, lines 61-63).

Since Deaton uses local customer databases, it clearly does not teach or suggest the use of a database of a third party. In addition, since Deaton is directed to a single enterprise, it could not provide the same functionality as that of the claimed invention which allows independent vendors to identify potential customers from another vendor's customer information.

In addition, the claimed database of the third party is limited to customer information provided by the plurality of independent vendors who independently provide data about their respective customers. In contrast, the Deaton "list of prospective customers of the retail store in a predetermined geographical area is obtained through conventional sources" (Deaton, col. 58, lines 63-65). Since the Deaton list of prospective customers is obtained through conventional sources, then there can be no teaching or suggestion in Deaton of a third party database containing information accumulated from a plurality of independent vendors who independently provide data about their respective customers or of the identification of potential customers within the database using a customer profile provided by a vendor of the plurality of vendors.

Since Deaton does not use a third party database or populate the database from a plurality of vendors or allow a vendor of the vendors to identify potential customer using a formed customer profile, Deaton does not teach each and every claim limitation. Since Deaton does not teach each and every claim limitation, the rejection is believed to be improper and should be withdrawn.

4. Allowance of claims 1-22, as now presented, is believed to be in order and such action is earnestly solicited. Should the Examiner be of the opinion that a telephone conference would expedite prosecution of the subject application, he is respectfully requested to telephone applicant's undersigned attorney.

Respectfully submitted,

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